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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,733	09/04/2003	Emrys J. Williams	5681-20500	7364
35690 7590 01/16/2007 MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C. 700 LAVACA, SUITE 800 AUSTIN, TX 78701			EXAMINER AGWUMEZIE, CHARLES C	
			ART UNIT 3621	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/16/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/654,733

Applicant(s)

WILLIAMS, EMRYS J.

Examiner

Charlie C. Agwumezie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/23/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1, 9, 15, 16, 26 and 39 are amended. Claims 1-39 are pending in this application per the response to office action filed on October 26, 2006.

Response to Arguments

2. Applicant's arguments with respect to claims 1-39 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-11, 14-16, 26-34, 36-37, and 39, are rejected under 35

U.S.C. 102(e) as being anticipated by Walker et al U.S. Patent Application Publication

No. 2006/0218098 A1.

As per **claims 1, 9, 15, and 16**, Wlaker et al discloses an Apparatus for use in transactions, comprising:

non-volatile memory containing a set of multiple identifiers associated with a same customer account, wherein said multiple identifiers are also known to an agency providing said customer account (fig. 1; 0025; 0026; "...plurality of predetermined single-use financial account identifiers..."), and

a processor operable to select for each of a plurality of transactions involving the same customer account, a different identifier from said set of multiple identifiers for use with the respective transaction (fig. 1; 0023; 0047; 0049; "...the encryption data changes for each use of the card so that ... card number is different for each transaction...").

As per **claim 2, and 10**, Walker et al further discloses the apparatus, wherein each of the identifiers in said set of multiple identifiers is allocated by the agency uniquely to the apparatus (figs. 1 and 10; 0049; 0093; "...instructing card holder to obtain a new device with list of single-use credit card numbers...").

As per **claims 3 and 11**, Walker et al further discloses the apparatus, further comprising a communications facility to engage a terminal, wherein the apparatus is operable to receive bill details for a transaction from the terminal, to generate a transaction record from the bill details, and to transmit the transaction record to the terminal (figs. 3 and 4; 0054; 0096).

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As per **claim 4 and 12**, Walker et al further discloses the apparatus, wherein the transaction record includes a digital signature that is generated using a cryptographic key contained within the non-volatile memory (0023; 0042; 0065; 0066).

As per **claim 5 and 13**, Walker et al further discloses the apparatus, wherein the transaction record is encrypted (0009; 0023).

As per **claim 7**, Walker et al further discloses the apparatus, wherein said apparatus is operable to engage a first class of terminals for making a transaction, and a second class of terminals to enter or to update account information stored in the non-volatile memory (fig. 3 and 4; 0093).

As per **claim 14**, Walker et al further discloses the method, further comprising limiting the transaction rate of the device to prevent rapid read-out of the identifiers (0046).

As per **claims 17 and 20**, Walker et al discloses a method for opening an account on a portable transaction device comprising:

opening an account record in an agency computer system, wherein said agency is to provide the account (fig. 10; 0047; 0093; "...instructing cardholder to obtain a new device with a new list of single use credit card numbers..."),

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generating a set of multiple identifiers to be used for transactions on the account (0049; 0093),

storing the set of multiple identifiers in the agency computer system (0093; 0097), and

storing the set of multiple identifiers on the portable transaction device (fig. 10; 0093; 0097).

As per **claim 18**, Walker further discloses the method, wherein the identifiers are unique to the account for the agency (0046; "...the number is unique for the specific input variable...").

As per **claim 19**, Walker et al further discloses the method further comprising adding the identifiers to an index, wherein said index maps from an identifier to the corresponding account (0047; 0097; "...transmitted credit card number matches listed in the credit card database...").

As per **claim 21**, Walker et al discloses the method wherein the identifier within said set of multiple identifiers are unrelated to one another (0046)

As per **claim 22**, Walker et al further discloses the method, wherein the identifiers are generated on the agency computer system, and are transmitted to the portable transaction device for storage thereon (fig. 10; 0047; 0093).

As per **claim 23**, Walker et al further discloses the method, further comprising generating at least one cryptographic key for use with the account (fig. 1).

As per **claim 25**, Walker et al further discloses the method, further comprising establishing an identity of a person who is to hold the account prior to opening the account (fig. 10; 0097).

As per **claim 26**, Walker et al discloses a method for performing a transaction at a terminal using a portable transaction device, comprising:

generating a bill for the transaction at the terminal (0045; 0097; "...cardholder uses device to generate transaction specific data..."),

engaging the portable transaction device with the terminal (figs. 3 and 4; 0047),

transmitting the bill from the terminal to the transaction device (0045; ...uses device to generate transaction specific data...),

selecting for each of a plurality of transactions involving a same customer account, a different identifier from a set of multiple identifiers stored on the transaction device for use in the transaction (fig. 1; 0023; 0047; 0049; "...the encryption data changes for each use of the card so that ... card number is different for each transaction..."),

generating a transaction record on the transaction device, the transaction record incorporating information from the bill and the selected identifier (0045; ...uses device to generate transaction specific data...), and

transmitting the transaction record to the terminal (figs. 3 and 4; 0045; 0047; "...transmits the single use number to the merchant...").

As per claim 27, Walker et al further discloses the method, wherein the transaction record includes a digital signature from the transaction device (0023; 0042).

As per claim 28, Walker et al further discloses the method, wherein the transaction device is associated with a customer account, and wherein said multiple identifiers are also known to an agency providing said customer account, the method further comprising:

transmitting the transaction record from the terminal to an agency computer (0047; "...merchant enters the single use number into authorization terminal connected to a central credit card processing system..."),

accessing an account record for the customer account based on the selected identifier included in the transaction record (0047; "...central system processor maps...card number onto conventional credit card account..."),

validating the transaction (0047; "...determines whether the transaction is authorized..."), and

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updating the account record in respect of the validated transaction (0093;
“...updated to change the status of the number from not used to used...”).

As per claim 29, Walker further discloses the method, wherein prior to transmitting the transaction record from the terminal to the agency computer, the terminal incorporates its own copy of the bill into the transaction record (0045; 0047).

As per claim 30, Walker et al further discloses a method of operating a computer account system at an agency, said agency maintaining a plurality of customer accounts on the computer account system, wherein each customer account has a set of multiple identifiers associated therewith, the method comprising:

receiving a request for a transaction on a customer account (0045; 0047),
accessing an identifier within the request (0047),
determining which set of multiple identifiers the accessed identifier belongs to,
and from this determining a customer account for the transaction (0047), and
updating the determined customer account in respect of the transaction (0093).

As per claim 31, Walker et al further discloses the method, wherein determining which set of multiple identifiers the accessed identifier belongs to comprises accessing an index that maps identifiers to corresponding account records (0047; “...central system processor maps...card number onto conventional credit card account...”).

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As per **claim 32**, Walker further discloses the method, wherein the request includes a digital signature generated by a transaction device associated with a customer account, and the method further comprises validating the digital signature (0023; 0042).

As per **claim 33**, Walker et al further discloses the method, further comprising opening a new customer account by: creating a new account record for the new customer account (fig. 10; 0093), and storing a set of multiple identifiers associated with the new customer account into the new account record (fig. 10; 0093).

As per **claim 34**, Walker et al further discloses the method, further comprising: generating the set of multiple identifiers associated with the new customer account (fig. 10; 0093), and transmitting the generated set of multiple identifiers to a customer transaction device for use with the new customer account (fig. 10; 0093).

As per **claim 35 and 38**, Walker et al further discloses the method, further comprising generating at least one cryptographic key for use in communications between the computer account system and the customer transaction device (fig. 1):

As per claims 36 and 39, Walker et al discloses a computer account system at an agency, said system comprising:

a plurality of customer account records, wherein each customer account record incorporates a set of multiple identifiers associated therewith (fig. 1; 0025; 0026;

“...plurality of predetermined single-use financial account identifiers...”), and

an index that maps identifiers to corresponding account records (0047; “...central system processor maps...card number onto conventional credit card account...”),

wherein the system is responsive to receiving a request for a transaction on a customer account to access an identifier within the request in order to determine which set of multiple identifiers and hence which customer account the accessed identifier belongs to (0047; “...central system processor maps...card number onto conventional credit card account...”).

As per claim 37, Walker et al further discloses the system, wherein the multiple identifiers associated with a customer account record are unique to that account record (0046; “...the number is unique for the specific input variable...”).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al at U.S. Patent Application Publication No. 2006/0218098 A1 in view of Mann, III et al U.S. Patent Application Publication No 2006/0122943 A1.

As per **claim 6**, Walker et al failed to explicitly disclose the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body.

Mann, III et al discloses the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body (0042; 0051).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, wherein said apparatus is provided within inert packaging to allow implantation into the human body as taught by Mann, III et al in order to ensure adequate security.

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5. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al at U.S. Patent Application Publication No. 2006/0218098 A1 in view of Pitroda U.S. Patent Application Publication No. 2005/0247777 A1.

As per **claim 8**, Walker et al failed to explicitly disclose the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory.

Pitroda discloses the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory (see figs. 3; 0014).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, further comprising first and second power circuits that are activated by said first and second class of terminals respectively, wherein activation of said second power circuit does not allow account information to be entered or updated in at least certain portions of said non-volatile memory in view of the teachings of Pitroda in order to ensure adequate security.

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6. **Claim 24** is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent Application Publication No. 2006/0218098 A1 in view of Wynn U.S. Patent No. RE38,137 E.

As per **claim 24**, Walker et al failed to explicitly disclose the method, further comprising making a prepayment onto the account prior to using the account for transactions.

Wynn further discloses the method, further comprising making a prepayment onto the account prior to using the account for transactions (fig. 10).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate the apparatus, further comprising making a prepayment onto the account prior to using the account for transactions in view of the teachings of Wynn in order to ensure adequate available credit.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

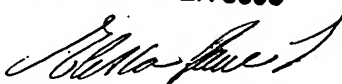
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charlie Lion Agwumezie
Patent Examiner
Art Unit 3621

Acc
December 26, 2006

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